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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,624	07/30/2001	Xiao Min Schebye	PA-0033 US	3179
27904	7590	09/15/2003		
INCYTE CORPORATION (formerly known as Incyte Genomics, Inc.) 3160 PORTER DRIVE PALO ALTO, CA 94304			EXAMINER CHAKRABARTI, ARUN K	
			ART UNIT 1634	PAPER NUMBER

DATE MAILED: 09/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/918,624	Applicant(s) SCHEBYE
	Examiner Arun Chakrabarti	Art Unit 1634
		
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --		
Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. <ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 		
Status <p>1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Jul 30, 2001</u>.</p> <p>2a) <input type="checkbox"/> This action is FINAL. 2b) <input checked="" type="checkbox"/> This action is non-final.</p> <p>3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11; 453 O.G. 213.</p>		
Disposition of Claims <p>4) <input checked="" type="checkbox"/> Claim(s) <u>1-19</u> is/are pending in the application.</p> <p>4a) Of the above, claim(s) _____ is/are withdrawn from consideration.</p> <p>5) <input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6) <input type="checkbox"/> Claim(s) _____ is/are rejected.</p> <p>7) <input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8) <input checked="" type="checkbox"/> Claims <u>1-19</u> are subject to restriction and/or election requirement.</p>		
Application Papers <p>9) <input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10) <input type="checkbox"/> The drawing(s) filed on _____ is/are a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p> <p>11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.</p> <p>12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>		
Priority under 35 U.S.C. §§ 119 and 120 <p>13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</p> <p>a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of:</p> <ol style="list-style-type: none"> 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). <p>*See the attached detailed Office action for a list of the certified copies not received.</p>		
<p>14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).</p> <p>a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.</p> <p>15) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.</p>		
Attachment(s) <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____</p> <p>4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input checked="" type="checkbox"/> Other: <i>Detailed Action</i></p>		

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DETAILED ACTION

Election/Restriction

Restrictions to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to a composition comprising a plurality of cDNAs that are differentially expressed in adipocyte differentiation, and are selected from SEQ: 1-71, and can be immobilized on a substrate, classified in class 536, subclass 23.1.
- II. Claims 6, 7, and 10 (N.B. it appears 10 should actually depend from 9 and not 7, but this restriction is written on the claims as presented), drawn to high throughput methods for detecting differential expression in a sample, classified in class 435, subclass 6.
- III. Claim 8, drawn to a method of using an unspecified cDNA to treat a subject classified in class 514, subclass 44. NOTE: if claim is amended to recite multiple SEQ ID Nos:, the Further Restriction listed below will be required.
- IV. Claim 9, drawn to a high throughput method of identifying a multiplicity of ligands that bind cDNAs, classified in class 435, subclass 7.1.
- V. Claims 11-14, drawn to isolated polynucleotides, vectors, and host cells, classified in class 536, subclass 23.1. FURTHER RESTRICTION APPLIED BELOW.
- VI. Claim 15, drawn to an isolated polypeptide, classified in class 530, subclass 350.
FURTHER RESTRICTION APPLIED BELOW.
- VII. Claims 16-17, drawn to a method of using a protein to screen for ligands, classified in class 435, subclass 7.1+. FURTHER RESTRICTION APPLIED BELOW.

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VIII. Claim 18, drawn to a method of producing an antibody, classified in class 530, subclass 388.1. FURTHER RESTRICTION APPLIED BELOW

IX. Claim 19, drawn to a method of purifying an antibody, classified in class 424, subclass 184.1. FURTHER RESTRICTION APPLIED BELOW.

Sequence election requirement applicable to Groups III, V-IX

In addition, each Group detailed above reads on patentably distinct SEQ ID Numbers. Each sequence is patentably distinct because the sequences are structurally unrelated sequences, and a further restriction is applied to each Group. Applicant must further elect a single SEQ ID NO. (See MPEP 803.04). For encoded proteins, the relevant DNA SEQ ID NO: must be provided. For methods of making antibodies, the relevant DNA SEQ ID NO: of the target protein must be provided. For any claims presently generic that read on a single sequence, or amended to recite a multiplicity of SEQ ID Nos, applicant must pick a single sequence.

Applicant is advised that examination will be restricted to only the elected SEQ ID NO. And should not be construed as a species election.

The inventions are distinct, each from the other for the following reasons:

The combination of cDNAs, the polynucleotide and polypeptide products of Groups I, V and VI can be shown to be distinct, each from the other. Although the polynucleotides and polypeptides are related as the claimed polynucleotide is asserted to encode the claimed polypeptide, they are distinct inventions because they are physically and functionally distinct

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chemical entities, and the protein product can be made by another and materially different process such as by synthetic peptide synthesis or purification from the natural source. Further, the DNA may be used for processes other than the production of the protein as evidenced by the methods of at least Group II. The combination composition product of Group I and the protein product of Group VI are structurally and functionally distinct from each other and from the polynucleotides of Group V. Group V is a single polynucleotide, while Group I has at least two sequences, and as many as 71.

The methods of Groups II-IV and VII-IX can be shown to be distinct, each from the other, as they have different starting materials, method steps, and goals. None of these methods are required to perform any other claimed methods, and they each use widely varying starting materials, have widely varying steps and each end in very different results.

These methods can be shown to be distinct from the products of Groups I, V and VI as each of these products is either not used in the methods of Groups II-IV and VII-IX or has uses unrelated to these methods. For example, the polynucleotides can be used to make the protein or as probes, the polypeptides can be used to make antibodies, and the antibodies can be used in method of purification.

Each group would require a non-coextensive literature search.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and the necessity for non-

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coextensive literature and sequence searches, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CAR 1.143). A fully responsive reply will comprise the election of both a group, and a particular sequence to be examined.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun Chakrabarti , Ph. D., whose telephone number is (703) 306-5818. The examiner can normally be reached on 7:00 AM-4:30 PM from Monday to Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (703) 308-1119. The fax phone number for this Group is (703)746-4979. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group LIE Chantae Dessau whose telephone number is (703) 605-1237.

Arun Kr. Chakrabarti
ARUNK CHAKRABARTI
PATENT EXAMINER
Arun Chakrabarti,

Patent Examiner

September 4, 2003

Gary Benzion
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